Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD ALLEN BERG, ALEX ALDEN PETERSON, MARK D. WAHLBERG and JON PATRICK ST. GERMAIN

Appeal No. 2002-1117
Application No. 09/569,607

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, all of the claims pending in this application.

As noted on page 1 of the specification, appellants' invention relates to structures that can be used to make connections between tubular medical grafts and a patient's tubular body conduits. More particularly, it appears that the

claimed graft connector is exemplified by that depicted in Figure 22 of the application and described on page 20 of the specification. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim can be found in Appendix A of appellants' brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Berg et al. (Berg '416) 6,074,416 Jun. 13, 2000

Claims 1 through 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Berg '416.

Rather than reiterate the examiner's full commentary regarding the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed April 5, 2002) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 11, filed March 21, 2002) and reply brief (Paper No. 13, filed June 10, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination which follows.

In rejecting claims 1 through 9 under 35 U.S.C. § 102(e), the examiner provides the following commentary

> Referring to all embodiments noting those shown in figures 10 and 23, Berg et al teaches an anastomoses connector comprising an annularly continuous structure having a plurality of first members and a plurality of second members. Berg et al teaches using a superlastic material such as nitinol (answer, page 3).

On pages 4 and 5 of the answer, the examiner further provides insight into his position by noting that the language "a structure which is annularly continuous and configured for disposition annularly within the inside of the tubular graft conduit" of claim 1 on appeal is merely functional language which the device of Berg '416 is fully capable of doing. Pointing to Figure 23 of Berg '416, the examiner contends that the connector

therein "strongly resembles appellants' device" and that the device of Berg '416

> can be used within a graft by the same method of appellants' or a maybe a different method and is properly rejected under 35 U.S.C. § 102(e) as being anticipated by Berg et al. A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the structural limitations of the that [sic] claimed (answer, page 5).

Having reviewed and evaluated Berg '416, we share appellants' assessment of the rejection on appeal and agree with appellants that Berg '416 does not disclose, teach or suggest a connector including "a structure which is annularly continuous and configured for disposition annularly within the inside of the tubular graft conduit" and having a plurality of first and second members extending from the structure as recited in claim 1 on appeal, with the first members

> being configured to pass through the side wall of the tubular graft conduit at respective locations that are spaced from one another around the side wall of the tubular graft conduit, and the first and second members being further configured to reach respective locations on the side wall of the tubular body conduit that are spaced annularly around the aperture when the connector is in use and the first and second members are extending substantially radially out from the structure.

With regard to the graft connector of Figure 23 in Berg '416, we note from the description thereof at column 8, lines 35-41, that patentee describes the connector as a "stand-alone" connector wherein the wire connectors (34) are attached to a ring structure (104) which is attached to the outside surface of a natural graft (106) by sutures (108). The connector and associated graft of Figure 23 is apparently intended to be installed in a suitable body conduit in the manner shown in Figures 10a-10c of Berg. Contrary to the examiner's position, we do not see that the connector of Figure 23 would be capable of being disposed within the inside of a tubular graft conduit and still function in the manner envisioned by Berg '416. In that regard, we agree with appellants' comments on pages 9-10 of the brief and pages 9-10 of the reply brief.

Simply stated, the examiner has provided no reasoning to support a conclusion that the connector of Berg '416 (Fig. 23) is structurally configured to be capable of functioning in the manner required in the claims before us on appeal, particularly claim 1. Even if the connector of Figure 23 may be capable of being positioned inside the natural graft (106), the examiner has not established that at least one set of the wire connectors (34)

are "configured to pass through the side wall of the tubular graft conduit at respective locations" as required in claim 1 and also "further configured to reach respective locations on the side wall of the tubular body conduit that are spaced annularly around the aperture when the connector is in use and the first and second members are extending substantially radially out from the structure."

As for the examiner's newly added comments regarding Figure 1 of Berg '416 (answer, page 6), we share appellants' view as expressed on page 7 of the reply brief that the wire frame (38) and coating (36), which fills the apertures formed by the wires of the frame, together define the "graft" or "graft conduit" of Berg '416. Thus, the frame (38) is part of the graft itself and is not "a structure which is annularly continuous and configured for disposition annularly within the inside of the tubular graft conduit" as required in appellants' claim 1 and which further includes first and second members configured to function in the manner set forth in claim 1.

In light of the foregoing, the decision of the examiner to reject claims 1 through 9 under 35 U.S.C. § 102(e) is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

CEF/lbg

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